

REMARKS

As a preliminary matter, applicants acknowledge with appreciation the Examiner's acknowledgement of the allowability of claims 16-31, 50, and 51 and the indication of the allowability of claims 12-15.

THE CLAIM AMENDMENTS

Claims 2 and 54 have been amended to remove the term "modified" from the preamble of the claims.

Claims 32-34, 36-45, 48, 52, and 53 have been amended to change the wording, but not the subject matter of the claims to more clearly define the invention. The changes made to the claims are discussed below in the response to the Examiner's indefiniteness rejections.

With the change to claim 48, claim 49 has been canceled.

Originally filed claim 1 has been reintroduced into the application as new claim 58.

The claim amendments set forth herein add no new matter to the application.

THE REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claims 2-5, and 54-57 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite; specifically, the Examiner is objecting to the use of the word "modified" in the preamble of claims 2 and 54. Claims 2 and 54 have been amended to remove the word "modified." With this change, this rejection is rendered moot.

Claims 32-47, 52, and 53 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite; specifically, the Examiner is objecting to these claims on the ground that the claims as filed are directed to the final products of a chemical reaction wherein the chemical structure is not fully specified. Claims 32-34, 36-45, 52, and 53 have been amended to recite a composition with a specific chemical structure as requested by the Examiner. Support for the changes to the amended claims is found throughout the specification, for example, at *inter alia*, paragraphs 0024 and 0145 for claims 32-34, and 36-45 and Example 6 for claims 52 and 53. Because the claims now recite specific structures, this rejection should be rendered moot.

Claims 48 and 49 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite; specifically, the Examiner is objecting to the claims on the ground that they do not recite a specific disease to be treated. Claim 48 has been rewritten to claim a method of inducing apoptosis in cancer cells, wherein the compound of anyone of claims 2, 6, 16, 26, or 58 is administered to the cancer cells.

Support for the change to claim 48 may be found throughout the specification, for example, at *inter alia*, paragraphs 0149-0151. With the change to claim 48, claim 49 has been canceled. Because claim 48 now recites a specific disease to be treated, this rejection should be rendered moot.

Because applicants have addressed and overcome the Examiner's three indefiniteness rejections, applicants respectfully request withdrawal of this rejection.

THE REJECTION UNDER 35 U.S.C. § 102(a)

Claims 6-11 stand rejected under 35 U.S.C. § 102(a) as anticipated by the compound in the Abstract of Pennington et al., ORGANIC LETTERS 4(22):3823-3825 (2002). This rejection is respectfully traversed.

Attached to the end of this paper are three Declarations under 37 C.F.R. § 1.131, one from each of the three inventors of this application that evidence that the claimed invention predates the October 1, 2002, publication date of Pennington et al. The Declaration of Orion Jankowski, Ph.D., to which a redacted notebook page is attached, describes the procedure that was used to functionalize the hydroxyl group array of apoptolidin to arrive at the apoptolidin analogs and derivatives of the claimed invention. Because one of the apoptolidin derivatives that were isolated using the procedure described in the notebook page is isoapoptolidin, the subject matter of original claim 1, which was previously canceled, has been reintroduced into the application as new claim 58. The notebook page attached to the Declaration of Orion Jankowski, Ph.D. has been redacted to hide the date of invention and the witnessing date; however, as sworn by Drs. Wender, Jankowski, and Tabet, this date predates the October 1, 2002, publication date of the Pennington et al. reference.

Because the claimed invention predates the publication date of Pennington et al., applicants respectfully request withdrawal of this rejection.


CONCLUSION

The foregoing discussion outlines and addresses each of the Examiner's rejections; accordingly, upon entry of this Amendment, there will be no outstanding issues requiring attention in this application. Because the claimed invention is definite and the date of invention predates the Pennington et al. reference, applicants respectfully request withdrawal of all claim rejections and passage of this application to allowance.

If the Examiner has any questions regarding this Amendment that may be addressed by way of a telephone call or e-mail correspondence, the Examiner is encouraged to contact the undersigned attorney at 650-251-7713 or at canaan@reedpatent.com.

Respectfully submitted,

By:


Karen Canaan
Registration No. 42,382

REED IP LAW GROUP
1400 Page Mill Road
Palo Alto, CA 94304-1124
650-251-7700 Telephone
650-251-7739 Facsimile